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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,844	09/08/2003	John M. Morales	026595-007510US	5408

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EXAMINER
GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
3692	

MAIL DATE	DELIVERY MODE
07/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/658,844	MORALES ET AL.
	Examiner	Art Unit	
	CLEMENT B. GRAHAM	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 October 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>11/24/2003</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 remained pending.

Hereby the finality of the office action mailed on December 31, 2008 is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lawrence U.S Pub: 2004/ 0024693 in view of Lawrence et al (Hereinafter Lawrence1,

U.S Pub: 2004/0006532).

As per claim 1, Lawrence discloses a method of producing a suspicious activity

report, comprising:

storing configuration information at a transaction processing device, wherein the

configuration information configures the device to produce suspicious activity reports based on

certain criteria("i.e. risk criteria" see column 6 para 0067-0072) receiving transaction

information(see column 2-3 para 0027 and column 3-4 para 0040 and column 5 para 0060

and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078) determining,

based on the transaction information and the certain criteria, whether a suspicious activity

report is to be prepared.(see column 1 para 0004 and column 2-3 para 0027 and column 5

para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and

column 3 para 0031and column 4 para 0044).

Lawrence fails to explicitly teach generating a suspicious activity report containing at

least some of the transaction information.

However Lawrence1 discloses information entered by a subscriber into a PRM system may be information gathered according to normal course of dealings with a particular network address or as a result of a concerted investigation. In addition, since the PRM system is proprietary and a subscriber responsible for the information contained therein can control access to the information contained therein, the PRM system can include information that is public or proprietary. If desired, information entered into the PRM system can be shared with a RMC system 106. Informational data can be shared, for example via an electronic transmission or transfer of electronic media. However, RMC system data may be subject to applicable local or national law and safeguards should be adhered to in order to avoid violation of such law through data sharing practices. In the event that a subscriber, or other interested party, discovers or suspects that a person or entity is involved in a fraudulent or otherwise illegal activity the system can report related information to an appropriate authority.(see column 1 para 0005 and column 4 para 0042 and column 5 para 0057 and column 10 para 0113).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lawrence to include generating a suspicious activity report containing at least some of the transaction information taught by Lawrence1 in order to provide suspicious activity report.

As per claim 2, Lawrence discloses further comprising transmitting the suspicious activity report to authorities. (see column 4 para 0044).

As per claim 3, Lawrence discloses wherein transmitting the suspicious activity report to authorities comprises:
collecting suspicious activity reports at a host computer system; and transmitting the collected suspicious activity reports to a computer system of the authorities.(see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 lines 0031and column 4 para 0044).

As per claim 4, Lawrence discloses further comprising receiving additional information and including the additional information in the suspicious activity report.(see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 lines 0031and column 4 para 0044).

As per claim 5, Lawrence discloses wherein generating a suspicious activity report comprises:
printing a suspicious activity report having a portion of the additional information and also having blanks for receiving additional suspicious activity report information.(see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 lines 0031and column 4 para 0044).

As per claim 6, Lawrence discloses wherein the certain criteria comprise a mandatory SAR threshold. (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 7, Lawrence discloses wherein determining whether a suspicious activity report is to be prepared comprises comparing an amount of a transaction to the mandatory SAR threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 8, Lawrence discloses wherein the certain criteria comprises a SAR prompt threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 9, Lawrence discloses wherein determining whether a suspicious activity report is to be prepared comprises comparing an amount of a transaction to the SAR prompt

threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 10, Lawrence discloses wherein determining whether a suspicious activity report is to be prepared further comprises:
displaying a prompt that asks an operator if he wants to prepare a suspicious activity report, and receiving a response to the prompt (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 11, Lawrence discloses wherein determining whether a suspicious activity report is to be prepared comprises determining whether an operator has elected to produce an on-demand SAR (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 12, Lawrence discloses further comprising printing a report relating to suspicious activity reports produced at the transaction processing device during a period of 3 time (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 13, Lawrence discloses wherein the transaction processing device is configured to print money orders (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 14, Lawrence discloses a transaction processing device, comprising:

an input device arranged to receive transaction information and SAR 3 information, a display
screen arranged to display information to an operator and application software that programs
the transaction device to:

store configuration information, wherein the configuration information configures the device to
produce suspicious activity reports based on certain criteria, receive transaction information
(see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6
para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and
column 4 para 0044) determine based on the transaction information and the certain criteria,
whether a suspicious activity report is to be prepared (see column 1 para 0004 and column 2-3
para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-
0076 and para 0078 and column 3 para 0031and column 4 para 0044).

 Lawrence fails to explicitly teach generating a suspicious activity report containing at least
some of the transaction information.

 However Lawrence1 discloses information entered by a subscriber into a PRM system
may be information gathered according to normal course of dealings with a particular network
address or as a result of a concerted investigation. In addition, since the PRM system is
proprietary and a subscriber responsible for the information contained therein can control
access to the information contained therein, the PRM system can include information that is
public or proprietary. If desired, information entered into the PRM system can be shared with a
RMC system 106. Informational data can be shared, for example via an electronic
transmission or transfer of electronic media. However, RMC system data may be subject to
applicable local or national law and safeguards should be adhered to in order to avoid violation
of such law through data sharing practices. In the event that a subscriber, or other interested
party, discovers or suspects that a person or entity is involved in a fraudulent or otherwise
illegal activity the system can report related information to an appropriate authority.(see
column 1 para 0005 and column 4 para 0042 and column 5 para 0057 and column 10 para
0113).

 Therefore it would have been obvious to one of ordinary skill in the art at the time the
invention was made to modify the teachings of Lawrence to include generating a suspicious

activity report containing at least some of the transaction information taught by Lawrence1 in order to provide suspicious activity report.

As per claim 15, Lawrence discloses wherein the certain criteria comprises a mandatory SAR threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 16, Lawrence discloses wherein the application 2software also programs the transaction device to compare an amount of a transaction to the mandatory SAR threshold. (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031 and column 4 para 0044).

As per claim 17, Lawrence discloses wherein the certain criteria comprise a SAR prompt threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 18, Lawrence discloses wherein the application software also programs the transaction device to compare an amount of a transaction to the SAR prompt threshold (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 19, Lawrence discloses wherein the application software further programs the transaction device to:
display a prompt that asks an operator if he wants to prepare a suspicious activity report; and receive a response to the prompt (see column 1 para 0004 and column 2-3 para 0027 and

column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 20, Lawrence discloses wherein the application software also programs the transaction device to determine whether an operator has elected to produce an on-demand SAR (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 21, Lawrence discloses wherein the application software further programs the transaction device to print a report relating to SARs produced at the transaction processing device during a period of time (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

As per claim 22, Lawrence discloses wherein the transaction processing device is configured to print money orders (see column 1 para 0004 and column 2-3 para 0027 and column 5 para 0060 and column 6 para 0067-0072 and column 7 para 0075-0076 and para 0078 and column 3 para 0031and column 4 para 0044).

Conclusion
RESPONSE TO arguments

4.   Applicant's arguments filed 10/17/07 has been fully considered but they are moot in view of new grounds of rejections.

5. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to CLEMENT B. GRAHAM whose telephone number is

(571)272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CG   /Kambiz Abdi/
July 10, 2008   Supervisory Patent Examiner,
                                                        Art Unit 3692